

REMARKS/ARGUMENTS

I. Objections to Specification

The Office observed that the specification is massively mis-formatted. Indeed, there are so many errors that the Applicant deems it proper to submit a substitute specification. Included with this response are: (1) a clean copy of the substitute specification and (2) a marked up copy showing changes of the substitute specification over the original.

The Office further objected that the disclosure fails to support previous amendments, presumably with respect to claims 24 and 44, which limits conduction to “at least 25% of the thermal energy is conducted into the target material”. These objections are obviated by cancellation of claims 24 and 44.

The Officer further objected that the disclosure fails to support a previous amendment, presumably with respect to claim 32, which recites in part “wherein said intermediate substance is gas containing absorbent particles.” This objection is obviated by cancellation of claim 32.

The Office further objected that the disclosure fails to support previous amendments, presumably with respect to claims 21 and 38 , which recite in part that “the intermediate substance...substantially prevents the absorbing material from penetrating into the target material.” Accordingly, claims 21 and 38 have been amended to eliminate the offending language.

Finally, the Office further objected that the disclosure fails to support a previous amendment, presumably with respect to claim 45. which recites “a heat removing device to remove heat from the target material.” The Applicant agrees that the specification does not refer verbatim to a “heat removing device”, but the specification does refer to heat removing substances and heat removing mechanisms (see Spec, page 35, line 16 to page 36, line 9). This objection is resolved by amending claim 45 to replace the term “device” with the term “mechanism”.

II. 35 USC 112

The Office rejected claims 21-25, 28-35, and 37-45 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 22-25, 29-35, 37, and 39-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly out and distinctly claim the subject matter which Applicant regards as the invention. Those issues are all resolved above.

III. 35 USC 102

Claims 12-24, 29-31, 33, 35, 38, 39, and 41-45 were rejected under 35 U.S.C 102(e) as being anticipated by Eppstein ('785). Claims 21-24, 29-31, 33, 35, 38, 39 and 41-44 were also rejected under 35 U.S.C. 102(e) as being anticipated by Eppstein ('699) and Eppstein ('578). Applicant respectfully traverse these rejections.

Independent claims 21 and 38 each recite in part that the absorbing material "transfers at least a portion of the absorbed energy to the skin without ablating the skin". (emphasis added). The Eppstein references are all directed to methods and devices having a primary purpose of producing ablation. Thus, those references not only fail to teach the currently claimed limitations, but actually teach against those limitations.

IV. 35 USC 103

Claims 25, 28, 32, 34, 35, 37 and 40 were rejected as being obvious over Eppstein ('785), Eppstein ('699), or Eppstein ('578) in combination with Neev. Applicant respectfully traverses these rejections. None of the references teach, suggest, or provide any motivation to one of ordinary skill in the art to transfer heat to skin via an intermediate substance. Still further, as pointed out above, each of the three references actually teaches against the claimed combination. references cannot be properly combined where one of them teaches against the claimed subject matter.

The mere existence in the prior art of individual features of a patented invention does not without more invalidate the patent under the obviousness test. There must be evidence that the bringing together of such features or steps would have been obvious to an ordinarily skilled person. It is improper to combine prior art references solely because the inventor's patent itself

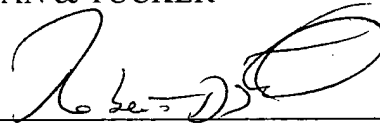
suggests the new combination of old elements. Thus, to combine any of the teachings of the prior art there must be some teaching or suggestion supporting the combination.... Further, you may not combine the features of prior products where the prior art itself teaches against the combination.¹

We conclude that the specification is inadequate as a matter of law in that regard primarily because it expressly teaches against it. Worse than being silent as to that aspect of the invention, the [prior art] specification clearly and strongly warns that such an embodiment would not wet well. In particular, the specification warns that silicon content above 0.5% in the aluminum coating causes coating problems. Such a statement discourages experimentation with coatings having more than 0.5% silicon, undue or otherwise. It tells the public that higher amounts of silicon will not work. Nothing further need be said about the matter.²

V. Request For Allowance

Claims 21-23, 25, 28, 29, 31, 33-35, 37-43 and 45 are pending in this application. The applicant requests allowance of all pending claims.

Respectfully submitted,
RUTAN & TUCKER

By 
Robert D. Fish
Reg. No. 33880

Rutan & Tucker, LLP
611 Anton Blvd., 14th Floor
Costa Mesa, CA 92626-1931
Telephone (714) 641-5100
Fax (714) 546-9035

¹ *Mitsubishi Elec. Corp. v. Ampex Corp.*, 190 F.3d 1300, 1309 (Fed. Cir. 1999).

² *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003).